III. REMARKS

With the above amendment, the Title of the Invention has been amended to correct errors made by the United States Patent and Trademark Office (USPTO), (See Confirmation No. 6950 Filing Receipt, mailed July 13, 2005). The claims have not been amended. No new matter has been added to the application by the present amendment.

A. The Invention

The present invention pertains broadly to a thermosetting resin composition such as can be used to manufacture printed wiring boards for electronic appliances. In accordance with the present embodiment, a thermosetting resin composition having the features recited in claim 1 is provided. Various other embodiments, in accordance with the present invention, are provided in the dependent claims.

One advantage of the thermosetting resin composition of the present invention is that it has excellent electric characteristics, flame retardancy, heat resistance, moisture resistance and adhesive properties.

B. The Rejections

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Tsuchikawa et al. (U.S. Patent 6,667,107 B2, hereafter the "Tsuchikawa Patent"), Ernst et al. (U.S. Patent 3,046,231, hereafter the "Ernst Patent"), and Kawase et al. (U.S. Patent 3,953,539).

Applicants respectfully traverse the rejection and request reconsideration of the above-captioned application for the following reasons.

C. Applicants' Arguments

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation to combine the references to produce the claimed invention. In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992); In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the scope and content of the subject matter taught by the references relied upon by the Examiner is insufficient to establish a prima facie case of obviousness because the Tsuchikawa Patent is not valid prior art for the purposes of a Section 103 rejection.

i. The Tsuchikawa Patent

The Tsuchikawa Patent pertains to "thermosetting resin composition and use thereof" and was published on December 23, 2003. Furthermore, as evident from the face of the Tsuchikawa Patent, it is assigned to Hitachi Chemical Co., Ltd. of Tokyo, Japan. On the other hand, the present application was filed on October 14, 2004 as a National Stage application of PCT/JP2003/004799, filed April 16, 2003, and which claims priority to Japanese Patent Application No. JP 2002-113017 filed April 16, 2002.

Pursuant to 35 U.S.C. § 365, a national application is entitled to the right of priority based on the prior filed international application designating the United States and at least one other country. As evident from the bibliographic data maintained by WIPO with respect to International Application No. PCT/JP/004799 (See Exhibit A, attached herewith), the present National Stage application meets the requirements of 35 U.S.C. § 365(a) and is entitled to a priority date of at least April 16, 2003. Consequently, the Tsuchikawa Patent is prior art only under 35 U.S.C. § 102(e).

Pursuant to 35 U.S.C. § 103(c), subject matter developed by another, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of 35 U.S.C. § 102, cannot preclude patentability under Section 103 where the subject matter and the claimed invention were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person.

U.S. Patent Application No. 10/511,102 and U.S. Patent 6,667,107 (the Tsuchikawa Patent) were, at the time the invention of U.S. Patent Application No. 10/511,102 was made, owned or subject to an obligation to assignment to the Hitachi Chemical Co., Ltd. of Tokyo, Japan.

Therefore, the Tsuchikawa Patent is not valid prior art for the purposes of establishing a Section 103 Rejection. No further comment regarding the disclosure of the Tsuchikawa Patent is believed to be necessary at this time.

IV. CONCLUSION

The Tsuchikawa Patent is not valid prior art against the instant claims for the purposes of establishing unpatentability under Section 103. Thus, the rejection under Section 103 is improper and must be withdrawn. Therefore, the Examiner has failed to establish a prima facie case of obviousness because the scope of the teachings of the Ernst Patent and the Kawase Patent fail to teach each and every element of the claimed invention.

For all of the above reasons, claims 1-12 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed attorney for applicants.

Respectfully submitted,

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